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IN THE

Supreme Court of the United States

OCTOBER TERM, 1958.

No. 850

NEW PRODUCTS CORPORATION,

Petitioner,

vs.

OUTBOARD, MARINE & MANUFACTURING COMPANY,

Respondent.

BRIEF IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

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ARGUMENT.

There are four basic reasons why the Petition for a Writ of Certiorari is without merit.

REASON 1.

Petitioner seeks to tender issues which are not raised by the record.

A. Under the heading "Questions Presented" (Pet. 2), Petitioner charges the Court of Appeals to have disregarded the trial court's findings (1(a)); to have ignored such findings (1(c)); and to have ar-

rived at a judgment contrary to the fact findings of the trial court (1(d)). The fact is that the judgment of the Court of Appeals was reached with due consideration for, and no disturbance of, the findings of the trial court. The Court of Appeals said (Petitioner's Appendix 7; 263 F.2d 521, 524):

> "Defendant's counsel are correct when they state:
>
> > 'The findings will be put in proper perspective if we point out that defendant could accept every finding, regardless of its correctness, and still be entitled to prevail on the issue of invalidity.'"

It is significant that the Petition for Certiorari fails to quote a single finding allegedly disregarded or ignored or requiring that the validity of the patent in suit be sustained.

B. Under "Questions Presented" (Pet. 2), Petitioner's 1(b) infers that the Court of Appeals based its judgment on testimony in conflict with testimony accepted by the trial court. This is entirely a spurious issue. The fact is that the judgment of invalidity by the Court of Appeals was based on concurring testimony by Plaintiff's and Defendant's witnesses. The Court said (Petitioner's Appendix 4):

> "—broaching and drilling are admittedly ancient practices usable by those skilled in the art according to the nature of the opening to be produced. Witnesses for both parties were in accord to that effect."

The Court then quoted from the argument of Plaintiff's counsel showing that the claimed invention of the patent in suit involved only the substitution of broaching for drilling. The Court held that this was no more invention

than the substitution of welding for riveting, which has been held non-inventive in *Leake* v. *New York Central R. Co.*, 110 F.2d 166, 168. It is significant that the Petition for Certiorari fails even to attempt to document its inference that the Court of Appeals overthrew a finding based on alleged conflict.

REASON 2.

The issues tendered by Petitioner are not controlling. In reversing the judgment of the trial court because the patent in suit lacked invention, the Court of Appeals did not rule upon either of two very significant defenses which would require adjudication in Respondent's favor if the ruling of lack of invention were to be reopened.

A. Respondent is entitled to a judgment of non-infringement because the claims are inapplicable to the methods practiced by defendant. The precise limitations which are avoided by Respondent's methods are the limitations which were relied upon by Banker in the Patent Office to secure the allowance of the claims in suit. There is no dispute of any nature as to the *fact* of what happened in the Patent Office or the *fact* of what the accused method is. There is no finding of *fact* which would require review for the purpose of adjudicating the issue of non-infringement between the parties. There is only the matter of applying the law to facts which are not in dispute. Finding No. 6 (R. 283) is the only finding involved, and this is in the nature of a conclusion. Finding 6 is not directed to any fact as such and is clearly erroneous in any event.

B. The patent in suit is void because of the priority of Hickling, who has an earlier filing date and earlier issue date of his patent 2,267,863, which clearly discloses the alleged invention of the patent in suit.

On the record in this case Hickling's priority is clear. There is *no* finding of fact on this issue of priority. If the Court of Appeals had not found the patent in suit void for lack of invention, it would necessarily have been constrained to find it void because of Hickling's priority. It is readily demonstrable, as a matter of law, that adjudication of Hickling's priority will invalidate the patent in suit without challenging any finding made by the trial court. If this case is to be reopened, the issue of priority as between Hickling and Banker will require determination.

REASON 3.

Petitioner merely states *without discussion* a question as to the effect on this case of the death of His Honor Judge Finnegan after hearing and prior to opinion. There is no apparent reason for Petitioner's failure to discuss this issue unless it *knows* that this issue has been adjudicated adversely to Petitioner's position. It is the law that the two surviving judges constitute a quorum for the adjudication of the appeal. (28 U.S.C. 46(d) and Rule 4 of the Court of Appeals of the Seventh Circuit) This Court so held in *Ayrshire Collieries* v. *United States*, 331 U.S. 132; 67 S. Ct. 1168, (1947). The law was more recently reviewed by Judge Hand in *United States* v. *Allied Stevedoring Corporation*, 241 F.2d 925 (CA 2, 1957).

REASON 4.

In reversing the district court for failure to apply the proper standard of invention to the facts as found, the Court of Appeals for the Seventh Circuit expressly followed the directive of this Court: *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147, 148, cited and applied by the Court of Appeals, in

its opinion in this case, 263 F.2d 521, 525. Manifestly, therefore, the opinion of the Court of Appeals herein could not have unsettled existing law or created confusion between the circuits as charged by Petitioner.

In the *A. & P.* case the patent had been held valid by both lower courts. This Court reversed on the ground that an improper standard of invention had been applied. Under the rule of the *A. & P.* case, where the facts fall short of establishing invention under the proper standard, a reviewing court is required to reverse the holding of validity as a matter of law, and there is no need for disturbing any of the findings of fact. See, for example, this Court's *per curiam* reversal without oral argument of the holding of patent validity in *Crest Specialty* v. *Trager*, 341 U.S. 912, 913.

In the case at bar, however, the Court of Appeals, as previously indicated, expressly stated that its decision does not disturb any findings made by the district court.

CONCLUSION.

Since the issues tendered by Petitioner have no semblance of merit, it is respectfully requested that the petition be denied.

Respectfully Submitted,

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